UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,470	07/31/2003	Robert Kincaid	10020348-1	5138

7590 02/28/2007

AGILENT TECHNOLOGIES, INC.
Legal Department, DL 429
Intellectual Property Administration
P.O. Box 7599
Loveland, CO 80537-0599

EXAMINER	
BRUSCA, JOHN S	
ART UNIT	PAPER NUMBER
1631	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/633,470	KINCAID ET AL.	
	Examiner	Art Unit	
	John S. Brusca	1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 December 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7 and 9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7 and 9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 December 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings were received on 26 December 2006 These drawings are accepted.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-7 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-7 and 9 are indefinite because it is not clear what is meant by the phrase "virtualizing microarray." The phrase is not defined in the specification, and it might be interpreted to be either data, or an apparatus that is a microarray, or an apparatus that processes a microarray. The claims are not distinctly limited to an apparatus comprising physical components.

Claims 1-7 and 9 are indefinite because it is not clear what is meant by the phrase "catalog microarray." The phrase is not defined in the specification, and it might be interpreted to be either data, or an apparatus that is a microarray. It is further indefinite because it is not clear how a catalog microarray differs from a microarray.

Claims 1-7 and 9 are indefinite for recitation of the phrase in claim 1 "data physically associated with the catalog microarray" because it is not clear how the data is physically associated since data is an abstract concept. It is not clear if the claims require a memory device

comprising the data to be attached to a microarray such as discussed on the paragraph bridging pages 14-15 of the specification.

4. Applicant's arguments filed 26 December 2006 have been fully considered but they are not persuasive. The applicants have cited a passage from page 13, lines 13-18 that discusses virtualizing microarrays. However the passage does not distinctly define what a virtualizing microarray is, but rather discusses some optional features and functions of one embodiment without distinctly stating what a virtualizing microarray is. The claims do not clearly point out what a virtualizing microarray is because the claims and specification use circular logic to discuss virtualizing microarrays, catalog microarrays, and virtual microarrays rather than defining the terms. It is not clear from the claims whether a virtualizing microarray is a machine or a combination of data and instructions. It is not clear what the claimed virtualizing microarray does, or whether it virtualizes something, or whether the virtualizing microarray produces a physical product, or whether the virtualizing microarray produces data, or how logic generates a virtual microarray from a virtualizing microarray, or what the relationship is between the virtual microarray produced by logic and the virtualizing microarray.

Regarding a catalog microarray, the applicants cite a passage from page 6, lines 7-20 that does not distinctly define the term, but gives optional features that a catalog microarray might comprise. If it can be assumed that a catalog microarray is a device with a plurality of attached probes, it is not clear what limitation the term "catalog" gives to the claimed subject matter. The claims require that the catalog microarray comprises features, and it is not clear that the features could not be data from a catalog.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6, and 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed subject matter includes embodiments that consist of data. Data is not within the statutory categories of invention defined by 35 U.S.C. 101. See MPEP 2106. Although claim 6 comprises limitations regarding methods of making the data, the claim is a product by process claim that is drawn to data.

6. Applicant's arguments filed 26 December 2006 have been fully considered but they are not persuasive. The applicants state that the claimed subject matter is a manufactured physical entity. However until the claims are clearly limited to components of a machine the claims will be interpreted to include embodiment that consist entirely of data.

Claim Rejections - 35 USC § 102

7. The rejection of claims 1-3, 5, and 6 under 35 U.S.C. 102(b) as being anticipated by Taylor (US 2002/0052882) in the Office action mailed 21 September 2006 is withdrawn until the metes and bounds of the claimed subject matter is clarified by the applicants.

Claim Rejections - 35 USC § 103

8. The rejection of claims 1 and 4 under 35 U.S.C. 103(a) as being unpatentable over Taylor in view of King et al. in the Office action mailed 21 September 2006 is withdrawn until the metes and bounds of the claimed subject matter is clarified by the applicants.

9. The rejection of claims 1 and 7 under 35 U.S.C. 103(a) as being unpatentable over Taylor in view of Ramdas et al. in the Office action mailed 21 September 2006 is withdrawn until the metes and bounds of the claimed subject matter is clarified by the applicants.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Brusca whose telephone number is 571 272-0714. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Irem Yucel can be reached on 571 272-0781. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

25 February 2007

John S. Brusca
Primary Examiner
Art Unit 1631

jsb